

REMARKS

New Reissue Inventor's Declarations

A new reissue declaration for inventor Randy D. Sines is being submitted. A declaration for co-inventor Steven L. Forte will be sent shortly in view of Mr. Forte's unavailability at the time this response is being filed.

The concerns expressed with regard to the original reissue declaration are believed to be properly and adequately addressed by the new declaration. The PCT application upon which priority is claimed has been identified. A Canadian application (Serial No. 2,190,266) corresponding to the parent U.S. Application Serial No. 08/439,687 filed May 12, 1995 has also been identified.

The earlier reissue declaration was also rejected as not properly indicating an appropriate error. It is believed the new declaration adequately addresses this concern. MPEP §1402 states that proper grounds for filing a reissue include "(A) the claims are too narrow or too broad". It also states that the case of *In re Wilder*, held that an attorneys failure to appreciate the full scope of the invention was held to be an error correctable through reissue.

The new declaration includes a warning against perjury as provided for in 37 C.F.R. § 1.68. It is respectfully requested that the new reissue declaration be accepted.

Recapture Rejection

The Office Action rejected unspecified claims under 35 U.S.C. §251 as being improper recapture of subject matter surrendered in the application leading to the original patent. However, this rejection is not consistent with the law of recapture.

The courts have held that 35 U.S.C. §251 should be interpreted liberally to effectuate the purpose of allowing errors in patents to be corrected. This is true specifically with regard to recapture as indicated in the case of *Hester Industries, Inc. V. Stein, Inc.*, which stated, "The reissue statute is to be construed liberally . . .", 142 F.3d at 1483-84, 46 USPQ2d 1650-51 (Fed. Cir. 1998).

The decisions on recapture indicate that rejection on the basis of recapture is not correct if the claims sought in reissue are materially different from the abandoned claims. *Riley v. Broadway-Hale Stores, Inc.*, 217 F.2d 530, 103 USPQ414 (9th Cir. 1954).

Another pertinent case is *In re Richman*, 409 F.2d 269, 161 USPQ 359 (CCPA 1969). In this case the court reversed rejection of reissue claims that were more restrictive in significant respects than the claims cancelled in the original application. At 409 F.2d at 274-75, the court stated,

We . . . find [no authority] for the proposition that a limitation added to a claim in obtaining its allowance cannot be broadened, under present statutory law, by reissue if the limitation turns out to be more restrictive than the prior art required. Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.

Another pertinent case is *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974). In this case the court held reissue claims had been improperly rejected. The court stated at 496 F.2d at 1207 the following:

This court . . . has made it clear that a reissue applicant is, at most, prevented by interpretations of the language of §251 . . . from obtaining claims which are of the same scope as the claims previously cancelled in the original application. As for obtaining claims on reissue which are different, no prohibition arises merely because of the language of the reissue statute.

The Federal Circuit held in *Ball Corp. v. United States*, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984), that a liberal approach is appropriate. The court upheld claims that were inclusive of feature surrendered during original prosecution because several elements were narrower. Certain aspects of the claims were broader. Thus the claims were materially different and sufficiently narrower than the cancelled claims to avoid the effects of the recapture rule.

In the case of *Mentor Corp. v. Coloplast, Inc.*, the Federal Circuit indicated that:

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were cancelled from the original application. . . . The recapture rule does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable

Although the court found the claims barred by recapture, this case confirms that materially different claims not surrendered in prosecution are properly the subject of a reissue application. The statute provides that broadening of claims can occur in reissue. The court holdings indicate you cannot

broaden to recapture what was intentionally abandoned. If the claims are materially different and narrower in some respects then reissue is proper.

This is further confirmed by MPEP §1412.02 which discusses in detail when a broadening reissue is properly or improperly rejected on the basis of recapture of cancelled subject matter. At page 1400-15 the text states that reissue claims that are broader in scope in some aspects, but narrower in others may avoid the effect of the rule against recapture. This passage cites *Mentor Corp. v. Coloplast, Inc.*

In the current application the claims presented in reissue are materially different from what was surrendered in the original prosecution.

The original claims cancelled were focused primarily on the methods involving counting of sequential jackpot tally events of either the dealer or players. Original claim 46 of the original application included a relatively broad step of “providing at least one special round at which the special player whose player count value met or exceed the special round player threshold is allowed to play under special rules in an effort to achieve a special round jackpot.” However, numerous other steps of that claim involved providing at least one player counter for player jackpot tally events; identifying all players who qualify for a player jackpot tally event;

incrementing the at least one player counter to selectively increase the player count values; and determining whether any player meets the special round threshold tally event count. Cancellation of such claim is not a surrender of the materially different and in many other respects narrower claims now presented in this reissue application. Accordingly, the rejection on the basis of recapture is inappropriate and contrary to established law. Application of such a rejection against the claims now pending in this application would violate the very purpose of §251 in allowing a patent applicant to seek reissue of claims having some broadening aspects where error has led to a failure to appreciate that other limitations clearly set out in the specification provide distinguishing and nonobvious subject matter. Elimination of the recapture rejection is appropriate under law and respectfully requested.

Discussion of Prior Art and Claims

The office action rejected the prior claims primarily upon the basis of the Breeding '892 reference. This reference describes a wagering method that includes play of a basic game. Players may optionally pay an entry fee. If a player pays the entry fee and has a predetermined winning hand

in the basic game, then the player receives a bonus award during play of the game and becomes eligible to potentially be in a secondary or subsequent tournaments. The tournaments are held at a later time involving finalist selected from those that became eligible. Eligibility does not assure participation in the subsequent tournaments. Even if eligibility leads to being a finalist, it requires later attendance, possibly at a different location. This methodology is disadvantageous for the indicated reasons and in particular because the player does not go on to play in the secondary game at the time of qualifying. Thus the teaching of Breeding is to a much different game.

Claim 55 recites a method that involves conducting a first casino card game about a gaming table according to first game rules. It further includes establishing at least one predetermined special round threshold event associated with play of the first game which acts as a trigger for conducting play of at least one special round game by a special player. It further recites suspending play of the first game upon occurrence of the threshold event and initiating play of the special round game. Still further it recites conducting the special round game and paying any special round bonus according to rules of the special game. It additionally recites

awarding any player suspended from the special round game a suspended player award as provided for according to the rules of the special round game.

This methodology is novel and nonobvious over the applied reference to Breeding. It provides that the special round is played at the gaming table upon occurrence of the threshold event. This is advantageous so that players do not have an interruption in the game. It is further nonobvious in providing that the suspended players may receive a suspended player award according to the rules of the game. This is advantageous and nonobvious in providing continued interest in the game even though one or more special players may be the focus of the game. In particular, the potential award to the suspended players maintains interest and creates a degree of camaraderie that enhances the play of the game at the gaming table and has all players interested in the special round play.

Claim 56 further adds the nonobvious aspect of awarding any suspended player award conditional upon paying a special round bonus to the at least one special player.

Claim 57 still further adds the nonobvious aspect of making any awards to the suspended players variable based upon the special player's

award during the special round. This is particularly nonobvious and advantageous in providing continued direct interest by suspended players in the special round play.

Claims 58 adds that the special round involves simultaneous play by the special player of a plurality of hands. This adds to the novel combination of claim 55 and is additionally patentable. It is advantageous in providing increased action during the special round.

Claim 59 is nonobvious for the same reasons as main claim 55 and additionally because it recites that the special round threshold event includes a plurality of events. This is not indicated in the applied Breeding reference in any form and is not obvious therefrom. The applied reference to Green teaches using consecutive events to award a bonus. It does not involve any special round play. It would not have been obvious to a person of ordinary skill in the art to provide the combination of steps recited by claim 59 based upon the limited teachings of Breeding and Green. Breeding does not provide for a secondary game at the time of play of the basic game and Green teaches only an enhanced award when there are consecutive events. Nothing in Breeding speaks to using consecutive events as qualifying conditions to the play of the tournament. Thus there is

no implication or reason for one of ordinary skill in the art to combine such references to render the claimed invention obvious. Similar arguments apply to dependent claims 60-62.

Dependent claims 63-67 are nonobvious for the reasons indicated with regard to main claim 55. Each includes additional limitations that further render the claimed subject matter of each claim nonobvious.

Claim 68 is another independent claim defining novel and nonobvious subject matter. Claim 68 recites among other steps the awarding of a suspended player award to any suspended players according to the rules of the special round. This is of particular attraction in providing continued interest by suspended players during the play of the special round. This in combination with other novel aspects of claim 68 define novel and nonobvious subject matter and allowance is respectfully requested.

Claim 69 further adds the nonobvious aspect of awarding any suspended player award conditional upon paying a special round bonus to the at least one special player because they may also win along with the special player.

Claim 70 still further adds the nonobvious aspect of making any awards to the suspended players variable based upon the special player's award during the special round. This is particularly nonobvious and advantageous in providing continued direct interest by suspended players in the special round play.

Claims 71 adds that the special round involves simultaneous play by the special player of a plurality of hands. This adds to the novel combination of claim 68 and is additionally patentable.

Claim 72 is nonobvious for the same reasons as main claim 68 and additionally because it recites that the special round threshold event includes a plurality of events. This is not indicated in the applied Breeding reference in any form and is not obvious therefrom. The applied reference to Green teaches using consecutive events to award a bonus. It does not involve any special round play. It would not have been obvious to a person of ordinary skill in the art to provide the combination of steps recited by claim 72 based upon the limited teachings of Breeding and Green. Similar arguments apply to dependent claims 73-78.

Dependent claims 79-83 are nonobvious for the reasons indicated with regard to main claim 68. Each includes additional limitations that further render the claimed subject matter of each claim nonobvious.

This case is now believed to be in full condition for allowance and favorable action is respectfully requested.